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In re Application of ANDREOLETTI et al. :
Application No.: 10/523,593 :
PCT No.: PCT/EP03/08926 : **DECISION ON PETITION**
Int. Filing: 12 August 2003 :
Priority Date: 14 August 2002 : **UNDER 37 CFR 1.47(a)**
Attorney Docket No.: 620-359 :
For: HETEROPOLYMERIC COMPOUND COMPRISING :
A SCAFFOLD, AN ADJUVANT AND AN ANTIGEN :
AND IT USE :

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 27 February 2006, in response to a Notification of Missing Requirements. Applicant requests a four month extension of time, which is granted.

BACKGROUND

On 04 February 2005, within thirty months of the priority date, applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 26 August 2005, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 27 February 2006, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signatures of inventors Pierre Andreoletti, Michel Julien and Emmanuel Risse. Applicant alleges that the inventors refuse to sign the application. The petition included the requisite petition fee, declarations signed by the joint inventors Laurence Dumon, Fergal Hill, Jean Marchand on their behalf and on behalf of nonsigning joint inventors and a statement of facts under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the \$200 petition fee. Item (3) is satisfied because the last known addresses for non-signing inventors were provided. With regard to Item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventors. Item (4) is satisfied.

With respect to item (2), joint inventor Fegal Hill's statement reflects the efforts he made or that were made by another on his behalf.

As stated in MPEP § 409.03(d), where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a *statement of facts by the person who presented the inventor with the application papers* and/or to whom the refusal was made. With regard to contacting each nonsigning inventor, Mr. Hill states that he forwarded "or had forwarded on my behalf" a copy of the declaration and the above identified application. His statement does not clearly indicate what first hand knowledge he possesses. A statement by the person who made efforts on Mr. Hill's behalf was not provided and is required. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature should be submitted.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition. *See* MPEP Section 409.03(d).

With regard to inventor Andreoletti, the papers allegedly were received on 17 October 2005. Petitioner states that the papers were signed for. However, Petitioner has not provided the evidence that a copy of the application papers including the declaration were *delivered to and received by Mr. Andreoletti*. Such evidence is needed to prove that Mr. Andreoletti received the papers and refuses to sign.

With regard to inventors Julien and Risse, the papers were returned to sender unopened.

The papers in both cases were marked indicating that the nonsigning inventor "did not live at the indicated address". No forwarding address was provided.

Section 409.03(d) states, in pertinent part: where inability to find or reach a nonsigning inventor "*after diligent effort*" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is temporarily unavailable (on vacation or out of town) to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, *by a person having firsthand knowledge of the facts recited therein*. Statements based on hearsay will not normally be accepted. *Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.*

Petitioner has not provided evidence of any diligent efforts made to locate the whereabouts of the nonsigning inventors Julien and Risse. A returned mailing does not demonstrate Messrs. Julien and Risse's refusal to sign the application. Since they are no longer available at their last known address, details regarding the diligent efforts to contact Messrs. Julien and Risse using Internet searches, telephone, e-mail or contacting the last known employment or the joint inventors regarding their whereabouts should be provided in a statement by a person having first hand knowledge of such search. This statement should demonstrate the diligent efforts undertaken to show the nonsigning inventors' unavailability. Petitioner has not provided sufficient evidence to conclude that Messrs. Andreoletti, Julien and Risse refuse or are unavailable to sign the application and thus, item (2) has not been met.

Petitioner has not satisfied Item (2) above and thus, the requirements of 37 CFR 1.47(a) are not satisfied at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

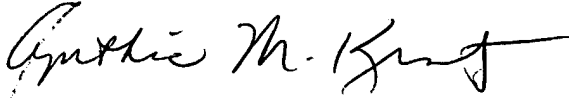
For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of
the letter marked to the attention of the Office of PCT Legal Administration.



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